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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERICH KAST, HANS-JOACHIM WILKE,
and PETER WEILAND

Appeal 2008-1532
Application 10/686,037
Technology Center 3700

Decided: September 23, 2008

Before TONI R. SCHEINER, DONALD E. ADAMS, and ERIC GRIMES, *Administrative Patent Judges*.

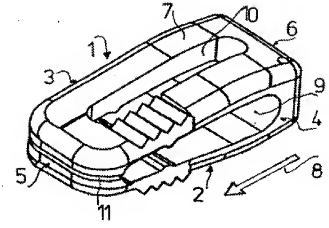
GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a spinal implant device, which the Examiner has rejected as anticipated or obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

BACKGROUND

The Specification discloses "an implant for placement between vertebrae" (¶ 0001). The application's Figure 1 is reproduced below:



The figure shows a perspective view of an incomplete embodiment of the disclosed implant (*id.* at ¶ 0017). "The shape of the implant deviates from a rectangular solid in that the height of the implant increases from the end face 5 towards the end face 6 to a maximum 7 and then declines again. The maximum height is located in the last third of the distance between the two end faces 5, 6." (*Id.* at ¶ 0023.)

The implant is intended to be "implanted in the direction of the arrow 8 by a dorsal approach through the vertebral canal that skirts the spinal cord" (*id.* at ¶ 0025).

DISCUSSION

1. CLAIMS

Claims 1 and 4-12 are pending and on appeal. The claims subject to each rejection stand or fall together because they have not been argued separately. 37 C.F.R. § 41.37(c)(1)(vii). Claim 1 is representative and reads as follows:

1. An implant for placement between vertebrae of a spine, wherein the implant has a shape adapted to a depression in vertebral surfaces facing the implant, wherein the implant has a height that increases from a ventral side to a dorsal side of the spine to a maximum height and then decreases again, and wherein the maximum height, viewed in a direction from the ventral side to the dorsal side of the spine, is located in a last third of a length of the implant.

2. ANTICIPATION

Claims 1, 4, 5, and 7-10 stand rejected under 35 U.S.C. § 102(b) as anticipated by Bernard.[1] The Examiner finds that Bernard anticipates claim 1 because "Bernard discloses an implant 1 having a height that increases from a ventral side 5 to a dorsal side 4 to a maximum height and then decreases again (see Figs. 1-3). The maximum height is located in a last third of a length of the implant (see esp. Fig. 3)." (Answer 3.)

Appellants argue that Bernard's implant has a maximum height nearer the side that attaches to an implantation tool and is intended to be implanted from the front of the body (Appeal Br. 5). "Consequently, if the implant is placed in the body as intended, the maximum height of the implant . . . is not located in the last third of the implant length but rather in the first third" (*id.*).

For this rejection, therefore, the dispositive issue is whether claim 1's references to the "ventral side" and "dorsal side" of the claimed implant distinguish the claimed device from the one disclosed by Bernard.

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[1] Bernard et al., FR 2 795 945 (July 9, 1999). The Examiner cites Bernard et al., U.S. Patent 6,964,687 B1 (Nov. 15, 2005), as an English-language equivalent to the French-language Bernard publication. Appellants do not dispute that the disclosures of the U.S. Patent and the French patent are equivalent.

We conclude that they do not. The references to the "ventral side" and "dorsal side" of the claimed implant refer to the orientation of the implant as it is intended to be used: It is intended to be inserted in an orientation that places the maximum height closer to the back of the patient.

The instant claims, however, are directed to an apparatus, not a method of inserting a spinal implant device. The claims therefore must structurally define the claimed device. A claimed device does not differ structurally from others based on how it is oriented when in use; e.g., its orientation when inserted into a patient.

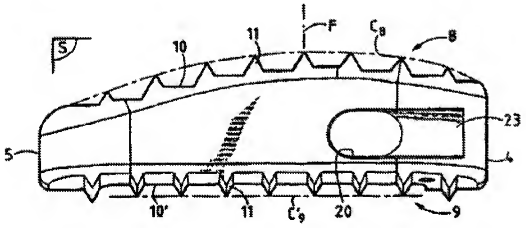
In re Pearson, 494 F.2d 1399 (CCPA 1974), is instructive. In that case, certain claims were directed to a "preparation for reducing pops and unsound kernels in peanut plants comprising, as an active ingredient, a calcium-containing compound" with a small particle size. *Id.* at 1401. The court held that the claim language stating the intended use of the composition did not limit the claims, so as to distinguish the claimed composition from the prior art. *Id.* at 1403.

The court concluded that "one of the compositions admitted to be old by the appellant would not undergo a metamorphosis to a new composition by labeling its container to show that it is a composition suitable for treating peanuts. . . . The container would still contain the old composition." *Id.*

Similarly here, a spinal implant that was otherwise identical to that defined by claim 1 would not undergo a metamorphosis to a new apparatus if it were placed into a patient with its maximum height toward the back of the patient rather than toward the front. Thus, the claim language referring to the "ventral side" and the "dorsal side" of the claimed implant relates to

its intended use, and does not distinguish claim 1 from an implant intended to be placed in the opposite orientation.

Bernard discloses "an intersomatic implant for insertion into the disk space defined between two adjacent vertebrae" (Bernard, col. 1, ll. 6-8). Bernard's Figure 3 is shown below:



The figure shows a side view of the disclosed implant (*id.* at col. 2, ll. 34-35). Bernard states that "the top transverse face 8 has a convex profile C_8 in the sagittal plane S" (*id.* at col. 3, ll. 25-28); i.e., when viewed from the side, the height of the implant reaches a maximum and then decreases again.

As we understand it, the Examiner and Appellants agree that the maximum height of Bernard's device is in the third of the device closest to one end. (See Answer 3 ("The maximum height is located in a last third of a length of the implant."); Appeal Br. 5 ("[T]he maximum height of the implant is located . . . in the first third.").[2])

[2] Although Appellants at one point state the "maximum of height [of Bernard's device] is somewhat outside of the middle of the half facing the chest" (Appeal Br. 6), they provide no basis on which to conclude that the

Appellants argue, however, that the "structural features of such implants can under no circumstances be taken into consideration separately from the intended implant location" (Appeal Br. 6). Appellants argue that Bernard's device "cannot be implanted turned by 180°. Because of its width, the implant can only be inserted from the chest side between two vertebrae." (*Id.* at 7.)

The Examiner responds that, while Bernard's device is intended to be inserted with the maximum height closer to the front, it is capable of being inserted the other way because it is "capable of being grasped on any portion thereof with forceps or by hand and of being inserted into a vertebral space in any desired orientation" (Answer 4-5).

We agree with the Examiner that claim 1 recites no structural features that distinguish the claimed device from the one disclosed by Bernard, even though the two devices are intended to be used in different ways. The rejection of claim 1 is affirmed. Claims 4, 5, and 7-10 fall with claim 1.

3. OBVIOUSNESS

Claim 6 stands rejected under 35 U.S.C. § 103 as obvious in view of Bernard and Bagga[3] (Office action mailed March 23, 2005, page 3). Claims 11 and 12 stand rejected under 35 U.S.C. § 103 as obvious in view of Bernard and Baccelli[4] (*id.*). The Examiner relies on Bernard for the teachings discussed above, and finds that Bagga and Baccelli disclose the additional limitations of the dependent claims (*id.* at 3-4). The Examiner

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maximum height of Bernard's device is not within one-third of its length from either end.

[3] Bagga et al., U.S. 2003/0125739, published July 3, 2003.

[4] Baccelli et al., U.S. 2003/0028249, issued Feb. 6, 2003.

concludes that the cited references would have made obvious the device defined by claims 6, 11, and 12 (*id.*).

We agree with the Examiner's reasoning and conclusion.

Appellants argue that "since dependent claims 6, 11 and 12 share the allowable features of claim 1, it is applicants[']' position that the rejections of claims 6, 11 and 12 under 35 U.S.C. § 103(a) are also in error and should be reversed" (Appeal Br. 8). This argument is unpersuasive because, for the reasons discussed above, we find that claim 1 is anticipated by Bernard.

SUMMARY

We affirm the rejection of claims 1, 4, 5, and 7-10 as anticipated by Bernard, the rejection of claim 6 as obvious in view of Bernard and Bagga, and the rejection of claims 11 and 12 as obvious in view of Bernard and Baccelli.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

dm

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